

Appl. No. 09/632,774
Amdt. Dated March 24, 2004
Response to Office action dated March 5, 2004

REMARKS

No claims have been amended, no claims have been canceled, and no new claims have been added. Claims 1-25 are therefore pending.

Requirement for Information

The Office Action requests "submission of information reasonably necessary to properly examine and treat the claimed subject matter." The Office Action further states that that:

[o]f particular interest is information used in drafting the present operation including information related to the field of endeavor or business practices used by applicants' professional business ventures, to show the information used in the invention process, and identification of any use of the claimed invention known to the inventor at the time the application was filed notwithstanding the date of the use.

(p. 4 of the Office Action)

However, it is unclear what exactly the Patent Office wishes to review and why. We ask that the Patent Office state in plain English what the Patent Office wishes us to provide. For example, please let us know whether the Patent Office desires press releases and product announcements concerning products that include the claimed invention, user manuals and help screens concerning the claimed invention, screen shots showing the claimed invention in use, advertisements for products that include the claimed invention. As of this time, we have not yet investigated whether any such information is currently available as it is unclear what we should investigate. Further, let us know if there is a particular time period for which the Patent Office desires the information requested.

In addition, please confirm that the following statement was erroneous: "the applicants are associated with SolVisions Technologies, International, which is in the business of the claimed invention, it appears that it would be appropriate to require the applicants to provide information necessary to ensure a quality examination be performed by the Office." [emphasis added] (p. 4 of the Office Action)

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Information Disclosure Statements

The Office Action states that the information disclosure statement filed September 1, 2000 fails to comply with 37 CFR 1.98(a)(2) in that a copy of reference AA was not provided. The Office Action further states that the information disclosure statements filed October 2, 2001 and September 1, 2000 fail to comply with 37 CFR 1.98(a)(3) in that there is no explanation of the relevance of references U through Z filed September 1, 2000 and reference W filed October 2, 2001.

We will be filing a new IDS listing the references requiring an explanation, including an appropriate explanation of the relevance of the references, and enclosing a copy of the missing reference (Ambrose WO98/35300).

Claim Rejections - 35 USC § 102

The Office Action rejects claims 1-25 under 35 USC § 102(b) and (e) as anticipated by various references. This rejection is respectfully traversed.

More specifically, the Office Action rejects:

- claims 1-6 under 35 USC § 102(b) as anticipated by Petrecca (US 5,781,894),
- claims 7-10 under 35 USC § 102(b) as anticipated by Golden (US 5,761,648),
- claims 11-14 under 35 USC § 102(b) as anticipated by West (US 5,845,259),
- claims 15-20 under 35 USC § 102 (e) as anticipated by Wendkos (US 5,983,196),
- and
- claims 21-25 under 35 USC § 102(b) as anticipated by LeLonde (US 5,283,731).

However, the Office Action states nothing further. The Office Action wholly fails to specify how each and every one of the limitations claimed are taught in any one of the references.

The patent rules require that:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. 37 CFR § 1.104(c)(2) (emphasis added)

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We assert that the cited references are complex and/or describe inventions other than that claimed. We also assert that the pertinence of each of the references is not apparent. We cannot determine those portions of the cited references that the Examiner asserts teach the limitations claimed.

Because the Office Action does not meet the requirements of 37 CFR § 1.104(c)(2), we hereby request that a new non-final office action be issued that:

- (1) clearly explains the pertinence of each of the cited references;
- (2) details how each and every one of the references cited in the 35 USC § 102 rejections teach each and every one of the limitations claimed; and
- (3) designates specific portions of the cited references which teach each and every one of the limitations claimed.

In the alternative, we request that this rejection be withdrawn in its entirety.

Claim Rejections - 35 USC § 103

The Examiner rejected claims 1-25 under 35 USC § 103(a) as obvious from the examiner's personal experience with the Patent Office computer system. This rejection is respectfully traversed.

More specifically, the Office Action states that the

examiner's personal experience with a system or method of displaying information to a user of an online service using a client application on a local device, the local device including an input device, the local device accessing an online server associated with the online service and providing interaction with the online service as provided by the Patent Office desktop computer used to search, examine, and develop Office actions for patent application.

(p. 7 of the Office Action, hereinafter the "Patent Office computer system")

We assert that the Examiner has failed to sufficiently set forth the features available on the Patent Office computer system and how they correspond to the limitations claimed. We assert that the examiner has failed to sufficiently set forth the time when the particular features were available on the Patent Office computer system.

The Examiner is directed to the patent rules which state that:

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When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee.

37 CFR § 1.104(d)(2)

We hereby request that the Examiner provide an affidavit attesting to those specific features of the Patent Office computer system that the Examiner asserts read on the claimed limitations. We also request that the affidavit state those dates that the Examiner asserts the features of the Patent Office computer system that the Examiner asserts read on the claimed limitations were in use. We further request that the Examiner provide an affidavit attesting to those specific features of the STN and DIALOG that the Examiner asserts read on the claimed limitations including the dates the features were in use.

In addition, so that we may evaluate the sufficiency of the Examiner's assertions, we request screen shots, user manuals and other information which shows those features of the Patent Office computer system, STN and DIALOG the Examiner asserts teach or suggest the limitations claimed. Importantly, the information provided must also show that the limitations claimed were in use prior to the filing date of the above referenced patent application.

In the alternative, we request that this rejection be withdrawn in its entirety.

In effort to move prosecution forward, we address the arguments asserted in the Office Action. The Office Action asserts that the Examiner using the Patent Office computer system to "search, examiner (sic) applications, and develop office actions are considered patentably equivalent to the claimed advertisements and/or sponsorship." (p. 9 of the Office Action) The Office Action further asserts that "[t]he claimed step of client application activating is considered functionally equivalent to examiner opening a desktop program to search or examine a patent application." (p. 9 of the Office Action) We find it difficult to comprehend how this description of a Patent Examiner performing tasks using the Patent Office computer system in any way teaches or suggests the limitations recited in the claims.

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The Office Action states that the Examiner's "experience does not expressly show the non-functional descriptive material features including advertisements and sponsorship data, label, or information." (p. 11 of the Office Action) The apparent argument being asserted in the Office Action is that moving bits of data between a client and computer machine cannot be patented because bits of data in the form of patent applications and Office Actions have been moved between client and server computers, even though the data recited in the claims is wholly different and includes, for example, "the sponsorship data comprising a sponsorship object including a resource locator associated with a sponsorship label to be displayed and a resource locator associated with a click-through of the sponsorship label." (step "d)" of claim 1) The analogy made in the Office Action fails to teach or suggest the kind of data and the relationship between the data as recited in the claims. This is just one example of how the Office Action fails to show how the Patent Office computer system teaches or suggests the limitations recited in the claims, and in particular, the kinds of data and relationship between the data recited in the claims.

Further, the Office Action apparently mistakenly cites to *In Re Gulack*. (p. 11 of the Office Action) The citation provided, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) refers to the matter captioned *In re Lowry*. The citation for *In re Gulack* is 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983). We ask that the Patent Office provide an accurate citation for the theory being asserted.

In addition, the Claim 1 recites a client application taking certain actions. Much of the argument made in the Office Action has an Examiner taking certain actions. For example, the Office Action states that "[t]he claimed step of client application commencing an online session with the online server is considered functionally equivalent to the examiner connecting to a web server for access to an off site database." (p. 9 of the Office Action) As such, the Office Action fails to show a client application taking certain actions, as a human Examiner cannot be the same as a client application.

For the reasons set forth in the prior paragraphs, we assert that the claims recite limitations neither taught nor suggested by the Examiner's personal experience with the Patent Office computer system.

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Double Patenting

The Office Action provisionally rejects Claims 1-25 stating that the claims in the currently pending patent application are not patentability distinct from the claims in two co-owned, co-pending patent applications (09/324,747 and 09/393,391). Should these Applications issue as Patents, and should the claims in this Application be in condition for allowance, we will address the provisional rejection at such future time.

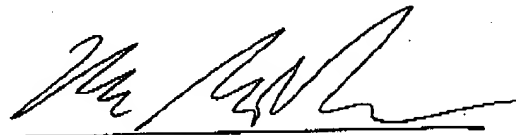
Conclusion

In view of all of the above, it is respectfully submitted that the present application is now in condition for allowance. Reconsideration and reexamination are respectfully requested and allowance at an early date is solicited.

The Examiner is invited to call the undersigned attorney to answer any questions or to discuss steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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